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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,496	07/28/2000	Mark Bresnan	F-192	3808

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/628,496

Applicant(s)

BRESNAN ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21,23-40 and 42-53 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21,23-40 and 42-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. In regard to the instant reissue application, the following has been noted:

A) an reissue declaration signed by the inventors Bresnan and Oh, which asserts an error has been received.

B) the consent of the assignee of US Patent no. 5,873,073 which is sought to be reissued by the instant reissue application, has been received.

C) the reissue declaration complies with 37 CFR § 1.175(a)(1) and 37 CFR § 1.175(a)(2).

D) an offer to surrender the original U.S. Patent 5,873,073 as required by 37 CFR § 1.178 has not been received on June 05, 2001.

E) the instant reissue application, which seeks to broaden the claimed invention, contains a new declaration executed by inventors Bresnan and Oh.

F) the instant reissue application, which seeks to broaden the claimed invention has been filed within two years of the issue date of US Patent no. 5,873,073.

G) new claims 20-51 as submitted do not conform to the requirements of 37 CFR § 1.121(b)(2)(ii), since the amendment was not accompanied by the required statements in support of the amended subject matter.

H) the prior art cited in the original patent, US Patent no. 5,873,073, has been cited in the Information Disclosure Statement filed July 28, 2000, and considered by the examiner.

I) in regard to the recapturing of claimed subject matter lost during the prosecution of the original patent, the original disclosure does not permit the use of a single printer to print both the contents and mailing information on the envelope. Therefore, the printers mentioned in the claims added by the instant reissue application must include the use of two separate printers. Hence, the deletion of the references to the first and second printers in the claims sought to be added by the instant reissue application is not an attempt to recapture claimed subject matter.

2. It is noted that the amendment filed 06 August 2001 does not conform to 37 CFR § 1.173; 37 CFR § 1.121(b)(1)(i); 37 CFR § 1.121(b)(1)(ii); 37 CFR § 1.121(b)(2)(i)(A); 37 CFR § 1.121(b)(2)(i)(C); 37 CFR § 1.121(b)(2)(iii); and 37 CFR § 1.121(b)(6), since:

A) the amendment filed 06 August 2001 does not conform to the requirements of 37 CFR § 1.173(b)(1) and 37 CFR § 1.173(d)(1,2), note amended paragraphs on pages 1 & 9-15 which do not contain the brackets and underlining relative to the text of the original patent as required.

B) the amendment filed 12 January 2004 does not conform to the requirements of 37 CFR § 1.173(b)(2) and 37 CFR § 1.173(d)(1,2), note in regard to:

(1) amended claim 1, in section (e) includes the following changes to this section, "(e) receiving said print job at said terminal node[;], said terminal node for receiving said print job and for directing said print job to a mail production means for producing said mail piece[;], said mail production means further comprising:", relative to patented claim 1, that have not been properly indicated in this version of claim 1;

(2) amended claim 18, which includes at line 3 an amendment to the sequence of text "node;[.] and,", however in patented claim 18 this sequence of text appears as "node; and,", hence, this amendment does not change patented claim 18; and

(3) claims 20, 21, 38, 40, 42 & 51 which do not appear in the original patent are not completely underlined as required for matter added to the original patent;

since the amended material does not contain the brackets and underlining relative that indicate changes to the text as it appears in the original patent as required.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

4. The amendment filed December 20, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall

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introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is described below.

4.1 Neither the disclosure of US Patent no. 5,873,073 nor the instant disclosure as originally filed provide support for using either permit mail or prestamped mail as an item of "unfinished mail". It is noted that as originally disclosed the recited purpose of the invention is to produce a finished mail piece. Further, as originally disclosed the finished mail piece of the instant disclosure is produced by franking an complete unfinished item of mail, that is a stuffed and sealed envelope, with an indication of postage payment before the item of mail may be placed in the mail stream, see at least:

A) the abstract "The invention is a method for producing a finished mail piece. The method allows a system user to select at a first node, a plurality of characteristics which define a mailing. These characteristics include selection of a document to be printed at a terminal node and a list of addresses to which the printed document will be sent. Once selections have been made, the print job is transmitted to a terminal node which comprises a data processor, an envelope printer, and a document printer among other elements. The document printer will print the document in accordance with the characteristics selected at the first node; and, the envelope printer will print addresses from the address list to corresponding envelopes. Once the document has been printed, it is inserted into the envelope by inserting means to form an unfinished mail piece. The unfinished mail piece is sealed and then franked with appropriate postage in order to form a finished mail piece. The mail piece is then placed into a mail stream for delivery to the destination address. A receipt indicative of the print job and delivery into the mail stream may be optionally generated by the terminal node and transmitted to the first node. Several nodal layers can be created such that the first node can transmit the print job to a second node which can further transfer the print job to subsequent nodes for printing and routing.";

B) the summary of the invention at page 2 "Once the document has been printed, the document is inserted into the envelope by inserting means to form an unfinished mail piece. The unfinished mail piece is sealed and then franked with

appropriate postage in order to form a finished mail piece. The mail piece is then placed into a mail stream for delivery to the destination address. A receipt indicative of the print job and delivery into the mail stream may be optionally generated by the terminal node and transmitted to the first node. An feature available is the use of postal coding and duplicate detection as applied to the address list.”; and

C) page 4, lines 7-17, “At step 118, the printed document is merged with the printed envelope to create an unfinished mailpiece. A number of different actions can be accomplished at this step. The printed media is manually or automatically inserted into the appropriate envelope, the envelopes can be stacked by stackers or redirected via transport means, weighed, and, the unfinished mailpiece can be sealed by a sealer if required. From step 118, the method advances to step 120 where the unfinished mailpiece is franked with appropriate postage by a postage meter and then placed into the mail stream at step 122.”.

4.1.1 Since, one of ordinary skill based on the original disclosure would have not recognized either permit mail or prestamped mail as being an item of “unfinished mail” with in the meaning of unfinished mail as provided in the instant disclosure, since these types of mail do not need to be franked with an indication of postage payment in order to create a finished item of mail that may be placed in the mail stream, neither permit mail nor prestamped mail would meet applicant’s own definition of unfinished mail as set forth by applicant in the original disclosure. Hence, applicant’s addition of the phrase “if it is not permit mail or mail having a postage stamp” to:

A) page 2, lines 37-47, “Once the document has been printed ... and then franked if it is not permit mail or mail having a postage stamp with ... duplicate detection as applied to the address list.”; and

B) page 4, lines 4-17, “At step 118, the printed document is merged ... is franked if it is not permit mail or mail having a postage stamp with ... into the mail stream at step 122.”;

adds new and unsupported additional disclosure which:

A) requires an new and unsupported decision to occur, that is a determination of whether or not the unfinished item of mail is required to be franked with postage in order to create a finished item of mail as originally disclosed or the originally disclosed allegedly unfinished item of mail is finished as originally disclosed, since it already has a mark indicating the payment of postage applied to the item of mail in which case the item of mail would be regarded as being finished; and

B) redefines the originally disclosed meaning of "unfinished" to include an item which would have been considered as being "finished" as defined in the original disclosure.

Therefore these amendments add new matter to the disclosure.

4.2 Applicant is required to cancel the new matter in the reply to this Office action.

5. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.1 The specification is objected to under 35 U.S.C. § 112, first paragraph, as:

A) failing to provide an adequate written description of the invention.

B) failing to adequately teach how to make and/or use the invention, (i.e. failing to provide an enabling disclosure).

C) the specification, as originally filed, does not provide support for the invention as now claimed.

5.1.1 As set forth above in section 4.1, the sequence of events is that the envelope is stuffed by inserting the contents into an addressed envelope and then the stuffed envelope is sealed. Next the sealed envelope is franked with an indication of the payment of postage. However, claim 38 as amended on 12 January 2004 clearly recites a sequence of events that would have franked the unsealed and unstuffed envelope with an indication of the payment of postage before the envelope has been stuffed. Therefore the sequence of events as recited in claim 38

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is inconsistent with the disclosure and produces a claimed invention that is not supported by the original disclosure so as to provide an enabling written description that would teach one of ordinary skill how to make and/or use the invention as now claimed.

5.1.2 Claim 38 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

6. Claim 23 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 Since claim 23 as filed 05 June 2001 depends from claim 22, which was cancelled by the amendment filed 12 January 2004, claim 23 is indefinite since neither the scope nor meaning of this claim can be determined.

6.2 For the above reason, applicant has failed to particularly point out what is regarded as the invention.

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7.1 Claims 1-4, 6-12, 15-21, 23-36, 38-40, 42-46 & 48-53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Cordery et al (5,628,249 or Harmon et al (5,684,706)

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or Baker et al (5,067,305) or Murcko et al (5,476,255) in view of Humes et al (5,377,120) and common practice.

7.1.1 In regard to claims 1-4, 6, 7, 11, 12, 15-21, 24-26, 29-36, 38-40, 43-46 & 58-53 either Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) disclose a computer mail processing system that creates mailing. Any one of these systems at a first computer/node creates the electronic data that describes the characteristics of one or more mail pieces, color, shape, size, postage class, include a reply envelope, etc. This electronic data further includes document data for each mail piece and the associated mailing list/data, i.e. destination data. The document data and mailing list are then merged into a single electronic data file, that is then sent/transmitted to a second processor/node.

7.1.2 At the second processor/node, the electronic data is parsed into envelope/postage data and document data, which is then sent to a mail production machine. The envelope data is used by a first printer to print address data and postage indicia on an envelope. While, the document data is used by a second printer to generate the document. The item mail is completed when the printed document is stuffed/inserted into the associated preprinted envelope and the envelope is sealed. The sealed envelope is then franked so as to produce a finished item of mail and placed in the mail stream for delivery to the destination printed on the item of mail.

7.1.3 Neither Baker et al ('305) nor Murcko et al ('255) nor Cordery et al ('249) nor Harmon et al ('706) disclose that the second processor/node is necessarily separate and not under the control of the first processor/node. However, Humes et al ('120) in the environment of mail processing discloses the following mail processing system. A third party, other the source of the mailing data/items, uses a computer system which is not co-located with the computer that is the source of the mailing data/items or under the control of the computer that is the source of the mailing data/items to collect mailing data that defines item of mail from a number of different mailers/sources. The collected mail data is then used to produce a finished item of mail in accordance with the mailing data, i.e. mail characteristics, mail document data and destination data, as sent from the source of the mail data/items. The production of a finished item by the third/independent party may include the third/independent party

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combining/merging documents from a number of mail sources into a single item of mail based on one or more mailing lists from the sources of the mailing data/item. The independent third party would then produce a merged mailing by printing the combined document data based on the mailing lists to create a finished item of mail that will be placed into mail stream of the postal system. It is noted that the documents and mailing lists are merged by the third party so as to remove incorrect and/or duplicate mailing address and to combine mailing documents to the same destination in such a manner so as to provide an overall lower mailing cost to each of the sources of mailing data/items. Since the system of Humes et al ('120) provides the benefit of lower mailing costs to a mailer, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) could be modified to use separately located mail production facility that is not co-located or under the control of the computer system that produced the mail data/items as the second processor/node to provide the functions of removing incorrect and duplicate mailing address and producing the finished mail item as taught by Humes et al ('120).

7.1.4 Further in regard to claims 1, 21, 25, 26 & 40, it is noted that neither Baker et al ('305) nor Murcko et al ('255) nor Cordery et al ('249) nor Harmon et al ('706) actually depict a postage meter. However, each of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) disclose that after the completed mail piece has been generated, the mail piece is franked and placed in the postal system for delivery. Since, the function of franking an item of mail commonly requires a postage meter or a system that provides the equivalent function/system of a postage meter, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) include a postage meter to produce a finished mail piece.

7.1.5 In regard to claims 8-10, since the systems of either of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) as modified by Humes et al ('120) and interpreted in view of common practice, require the transmission of the mailing data/file from one node to the next with out restricting the type of communications path/link being used, it

would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706)) as modified by Humes et al ('120) and interpreted in view of common practice could include any number of nodes absent applicant's indication of unexpected results from a particular number of nodes.

7.1.6 In regard to claims 23, 27 & 43, since the systems of either of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) as modified by Humes et al ('120) and interpreted in view of common practice, require the determination of the appropriate amount of postage for an item of mail and the size, shape, weight affect the require postage, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706)) as modified by Humes et al ('120) and interpreted in view of common practice would consider the characteristics of the item of mail when determining the require postage.

7.1.7 In regard to claim 28, since the systems of either of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) as modified by Humes et al ('120) and interpreted in view of common practice, transmit the mailing data/file from one node to the next with out restricting exactly or how the print file is formed and transmitted, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706)) as modified by Humes et al ('120) and interpreted in view of common practice could generate the print filed as a combined file of the mailing list file and document file or a file of individual complete items of mail absent applicant's indication of unexpected results from a particular method of transmitting the print file.

7.2 Claims 5, 37 & 47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Cordery et al (5,628,249 or Harmon et al (5,684,706) or Baker et al (5,067,305) or Murcko et al (5,476,255) as modified by Humes et al (5,377,120) and in view of common practice as applied to claims 1, 20 & 38, and further in view of common business practice.

7.2.1 In regard to the receipt of claims 5, 37 & 47, the systems of either Cordery et al ('249 or Harmon et al ('706) or Baker et al ('305) or Murcko et al ('255) as modified by Humes et al ('120) and in view of common practice require the mailing data to be sent and processed by a third party. Further, it is common business practice by a service provider to be required to provide a receipt as proof that a service has been provided before the service provider is paid for that service. Hence, it would have been obvious to one of ordinary skill at the time the invention was made that the operator of any one of the systems of either Cordery et al ('249 or Harmon et al ('706) or Baker et al ('305) or Murcko et al ('255) as modified by Humes et al ('120) and in view of common practice, would require the third party to provide a receipt as is common business practice.

7.3 Claims 13 & 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Harmon et al (5,684,706) as modified by Humes et al (5,377,120) and in view of common practice as applied to claims 1, 11 & 12.

7.3.1 In regard to claims 13 & 14, Harmon et al ('706) further discloses that a second central computer system checks to see if the supplies required to generate the mail piece(s) are available at anyone of a number of mail piece generating stations. And schedules the task of generating the mail piece at the appropriate mail piece generating station.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

8.1 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Response to applicant's arguments.

9.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

9.2 It is noted that applicant still has neither address nor complied with the requirement to correct the amendments of 06 August 2001.

9.3 As per the new matter objection and the 35 U.S.C. § 112 1st paragraph rejection, since:

A) one of ordinary skill at the time the invention was made would have realized that neither permit mail nor prestamped mail would meet the definition of finished mail as set forth in the original disclosure, applicant's argument's are non persuasive.

9.3 As per the 35 U.S.C. § 103 rejection, since:

A) one of ordinary skill at the time the invention was made would have realized that:

(1) the node of the instant claims is nothing more than a computer implemented system to perform particular functions and is connected to a network;

(2) as argued by the examiner, the functions/operations of the claimed invention are recognizably present with in the operations/functions of either Cordery et al (5,628,249 or Harmon et al (5,684,706) or Baker et al (5,067,305) or Murcko et al (5,476,255) in view of Humes et al (5,377,120), regardless of how applicant may believe these references have been used by the examiner; and

(2) once the generated/created mailing data/list is sent from the originator to a separate and distinct the third party in the systems of either Cordery et al (5,628,249 or Harmon et al (5,684,706) or Baker et al (5,067,305) or Murcko et al (5,476,255) in view of Humes et al (5,377,120) only the computer system/network of the third party may control the production of the items of mail.

Hence, is arguing unclaimed distinctions and merits and applicant's argument's are non persuasive.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

04/21/05


Edward R. Cosimano
Primary Examiner A.U. 3629